

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

AMJADI

Application No.: 09/251,480

Filed: February 17, 1999

Title: INCENTIVE NETWORK

Confirmation Number: 3291

Group Art Unit: 2151

Examiner: Dinh, Khanh Q

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the pending rejection in the above-identified application. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided in the **Remarks** beginning below. A total of 5 pages are provided.

No additional fees are believed necessary. If any extensions of time are necessary to prevent abandonment, they are hereby petitioned for under 37 C.F.R. § 1.136(a). If any fees are required for any purpose, authorization to charge our Deposit Account No. 033975 (**Ref. No. 031792-0311576**) is hereby granted.

REMARKS

One aspect of the invention relates to an incentive host server that stores and enables users to request incentives (e.g., coupons). The incentive host server receives requests from users via user devices. The requests are made by the user from one of a number of networks associated with the incentive host server. For example, a first network server may be a website server (e.g., washingtonpost.com) and a second network server may be another website server (e.g., pets.com). As detailed below, various novel aspects of the invention enable certain coupons to be made available to visitors who access the incentive host server via the first network server and different coupons may be made available to visitors who access the incentive host server via the second network server.

Each user device (e.g., computer) can have a first identifier (e.g., device identifier). Each network can have a second identifier (e.g., a network identifier or NID). Thus, requests received by the incentive host server can include a first ID and/or the NID. This enables,

among other things, the ability to target/filter coupons based on: i) information associated with the user/device (e.g., demographic information) and ii) information about the network from which the request is made. Thus, certain coupons in the incentive host server may be available to users of a first network and others may be available to users of a second network. Further user/device filtering can be performed as well. In this way, the coupon (or other incentives) can be targeted based on either or both of these criteria. The prior art is completely missing at least the filtering by network ID aspect, much less a common incentive host server which can be accessed from different networks.

Claims 1-36, 39-41, 44-50 and 52-59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Scroggie et al., U.S. Patent 5,970,469 (“Scroggie”) in view of Walker et al., U.S. Patent 5,949,875 (“Walker”). The 103 rejection is improper at least because 1) Neither Scroggie nor Walker, alone or in combination, teach or suggest all of the claim features; 2) Walker is non-analogous art; and 3) there is no legally proper teaching, suggestion, or motivation to modify Scroggie to include the teachings of Walker.

1. Scroggie and Walker fail to teach or suggest all of the claim features

The Examiner continues to erroneously allege that Scroggie discloses “at least one incentive host server and at least two network servers” and “receiving, at a network server, an access request from a client device associated with the user.” Independent claims 8, 11, 18, 21, 44, 34, 39, 48, 53, 54, and 57 recite similar features. The Examiner argues that the point of sale *scanner* 312 constitutes one of the network servers and the incentive distribution server 300 constitutes the other network server (see Office Action, pg. 3). In other cases, the Examiner alleges that the in-store kiosk 310 qualifies as the other network server.

It is beyond cavil that a handheld bar code scanner is not an “incentive network server.” This position is wholly without merit. The Examiner provides not a scintilla of evidence that one of ordinary skill in the art would interpret a handheld bar code scanner as a network server, despite having been challenged on this point repeatedly. Of course, the scanner itself does not store an incentive database. Considering this claim as a whole, the rejection also fails because even if a scanner were misconstrued to be a network server, no “client device” makes an access request for incentives from a barcode scanner. The Examiner’s need to resort to such creative mischaracterizations of clearly articulated elements highlights the weakness of the rejection.

As such, it is clear that the strained rejection is legally improper since, properly construed, Scroggie fails to teach and/or suggest a plurality of network servers (and “two more network servers”), as claimed.

The Examiner further admits that Scroggie fails to disclose “a network server identifier (NID) to identify available incentives” (see Office Action, pg. 4). The Examiner attempts to rely on Walker to make up for this deficiency. Walker, however, fails to even disclose incentives, much less an NID used to identify available incentives. The references, alone or in combination, fail to disclose, teach, or suggest all of the elements of the claims. For this reason alone the rejection is legally deficient.

Walker relates to a telephonic billing and purchase verification system and has nothing at all to do with identifying available incentives using an NID. Walker discloses an access management computer that controls a user’s access to digital data located at a data site, while causing a 900-number network to toll the user’s access to the data. The user submits an access code (also referred to as a session code and/or purchase code) via a 900-number that corresponds to the users access to digital data. The access management computer verifies that the submitted access code corresponds to a stored access code thereby authorizing the user’s access to the digital data. Based on the access verification, the access management computer authorizes the 900-number to post an access charge to an account associated with the user. See Walker, col. 3 lines 5-23. At a minimum Walker fails to disclose the use of an *NID to identify available incentives*.

The present invention makes clear that available incentives are determined (and transmitted to the client device so that the user can select the desired ones of the incentives). The determination by the incentive host server of incentives available for a particular request is based in part on the NID. Optionally, it is based on user/device information as well. Walker is devoid of any such teaching or suggestion.

2) Walker is non-analogous art

The Office Action fails to provide any evidence or establish that Walker is analogous art. First, Walker is not within the field of the inventor’s endeavor. Walker, as stated above, relates to a billing system linked to a separate telephone connection associated with a billing network that manages and bills for access to information over a computer network. See Walker, *e.g.*, col. 1, lines 12-15. This is not the same as the Applicant’s field of endeavor which relates to an incentive network for distributing incentives on a network wide basis and

for permitting users access to incentives from any network server, thereby improving the incentive distribution and redemption processes. *See* Specification, *e.g.*, pg. 1, lines 3-6.

Secondly, Walker is not reasonably pertinent to the particular problem(s) with which Applicants were involved. Walker is more concerned with the problem of collecting payments for disseminating information over data networks. *See* Walker, *e.g.*, col. 1, lines 23-26. The problems addressed by the Applicants include providing secure, targeted and trackable incentives (*e.g.*, coupons) to consumers who access a common incentive host server via a client device (*e.g.*, personal computer) through any one of a number of different other network servers (*e.g.*, network servers on which different web sites are hosted) within a network.

The Examiner has not established that a person having ordinary skill in the art would reasonably have been expected to solve the problem(s) of providing targeted and trackable incentives, by considering the problem(s)/solution of Walker. The Office Action is devoid of any evidence to support the Examiner's position. As such, Walker cannot properly be used in an obviousness rejection. Even if it could, it still fails to teach the deficiencies of Scroggie.

3. There is no legally proper teaching, suggestion, or motivation to modify Scroggie to include the teachings of Walker

Assuming *arguendo* that Walker is deemed analogous, which is not admitted, the Examiner has failed to set forth a legally proper teaching, suggestion, or motivation to modify Scroggie. For example, the Examiner admits that Scroggie does not disclose the claimed feature of "a network identifier (NID) to identify available incentives." *See* Office Action, *e.g.*, pg. 4, lines 1-2. The Examiner relies on Walker, however, for this feature, alleging that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement Walker's teachings into the computer system of Scroggie to monitor access information because it would have tracked the codes necessary to manage the information purchase process in a communications network.

[Office Action, pg. 4]

This is legally deficient. Even if what the Examiner says is true (which is not admitted), it fails to provide a proper legal suggestion or motivation to modify Scroggie in light of Walker *to arrive at the claimed invention*. A simple statement that a modification or combination would have been obvious to one of ordinary skill in the art is not sufficient to provide a motivation for the proposed combination, absent a teaching within the references themselves, or in the knowledge generally available to one of ordinary skill in the art,

suggesting a desirability of combining the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), and *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The alleged motivation recited in the Office Action fails to provide any reasoning why there would be a desirability to combine the ability to track codes necessary to manage the purchase of information over a network to Scroggie which has nothing to do with the purchase of information over a network nor does it suggest remedying the admitted deficiencies of Scroggie (using an NID to identify available incentives). Accordingly, the Examiner has engaged in a classic exercise of hindsight reconstruction to pick and choose among separate disclosures to allegedly arrive at Appellants' claimed invention. But even then, the combination falls short, because neither reference discloses the admitted missing element from Scroggie.

For at least the reasons set forth above, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103. Accordingly, the rejection of claims 1-36, 39-41, 44-50 and 52-59 is improper and must be reversed.


Claims 37, 38, 42, 43, and 51 are rejected under Section 103 over Scroggie and Walker in view of U.S. Patent 6,055,573 to Gardenswartz et al. ("Gardenswartz"). The Examiner does not even allege that Gardenswartz overcomes the deficiencies of Scroggie and Walker described above with respect to the independent claims. As such, these dependent claims are patentable as well for at least these reasons in addition to the deficiencies of Gardenswartz.

If, for any reason, a personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,
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